

REMARKS

Applicant is submitting herewith a proposed change to the drawing wherein Figure 5 now shows a heat conducting glue 33'. Assuming that the proposed change meets with the Examiner's approval, a new formal drawing will be submitted prior to payment of the Issue Fee. The specification has also been amended to add the number 33' after heat conducting glue. Claim 8 has also been rewritten to overcome the Examiner's objections.

Original claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over JP-5851052 in view of U.S. Patent Number 5,704,250 to Black and DE-4335654. In making that rejection the Examiner recognized the Japanese '052 reference lacks the limitation of the ball screw having cooling means wherein the agent is a cooling agent that reduces the temperature of the screw nut and lacks the limitation wherein a heat conducting glue is provided between the guiding tube and the screw nut. The Examiner went on to argue that Black teaches in Figure 3 the use of a ball screw with cooling means wherein the agent is specifically a cooling agent that flows through the cavity 86 formed between the screw nut 56 in the outer cover 36. The Examiner also stated that it would have been obvious to one of ordinary skill in the art to have modified the agent of JP '052 to have been a cooling agent as taught by Black in order to provide a means of preventing overheating of a screw nut and to provide an alternate means of helping to prevent thermal expansion.

It is Applicant's contention that the above reasoning is based on Applicant's disclosure and that it would not have been obvious to do so as alleged by the Examiner. Further, the Examiner said that DE '655 teaches that pipes carrying either a heating or cooling agent being attached to a nearby object by way of heat conducting glue.

It is Applicant's contention that amended claim 8 now calls for a spirally disposed guiding tube for guiding fluid of the cooling agent installed in the cavity to perform its cooling function without directly contacting the outer cover thereby eliminating cooling agent leakage. Further, amended claim 8 now calls for wherein said cavity is filled with said heat conducting glue between said guiding tube and said screw nut.

It is respectfully submitted that these features are not disclosed or suggested by the prior art. Accordingly, it is Applicant's contention that amended claim 8 and dependent claim 10 are now in proper form and should be allowed.

Applicant's contention is further supported by *In re Rouffet*, 47 USPQ 2d 1453 (CAFC 1998):

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements.") Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

In view of the above, it is Applicant's contention that amended claim 8 and dependent claim 10 should be allowed.

Respectfully submitted,

Date: June 24, 2004

By.: 

David E. Dougherty

Registration No.: 19,576

Dennison, Schultz, Dougherty & MacDonald
1727 King Street
Suite 105
Alexandria, VA 22314
Tel: 703-837-9600 - Ext. 17
Fax: 703-837-0980